

Appl. No. 09/770,577  
Amdt. dated April 11, 2005  
Reply to Office Action of Jan. 10, 2005  
Docket No. 6169-145

IBM Docket No. BOC9-1999-0092

### REMARKS/ARGUMENTS

These remarks are made in response to the Office Action of January 10, 2005 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due.

On page 2 of the Office Action, the Examiner has rejected claims 1-3, 5-11, and 13 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,694,295 to Lindholm, *et al.* (Lindholm).

In response to the Office Action, Applicants have amended claims 1, 6, 7, and 9 to emphasize the utilization of a threshold value representing a maximum number of selections that the portable computing device is able to process within a designated period of time, as supported by page 17, lines 2-23. Claims 2 and 10 have been amended to be consistent with amended claims 1 and 9. Claims 3 and 11 have been amended to clarify that the notifying uses an audio prompt or a physical prompt, as supported by page 18, lines 5-8. New claim 14 has been added to emphasize that the threshold value is based upon the processing power of the portable computing device, as supported by page 17, lines 3-8. New claim 15 has been added to emphasize that the threshold value is a user programmable value, as supported by page 17, lines 9-10. No new matter has been added as a result of the above amendments.

With regard to the rejections on the art, the Examiner has rejected claims 1-3, 5-11, and 13 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,694,295 to Lindholm. Lindholm fails to disclose every feature of Applicants' invention as amended. Specifically, Lindholm fails to teach or suggest the limitations of a threshold value. That is, Lindholm fails to contemplate comparing a set of selections against a threshold value that represents a maximum number of selections and fails to teach that the portable device performs a speech recognition task when the set of selections favorably compares with the threshold value.

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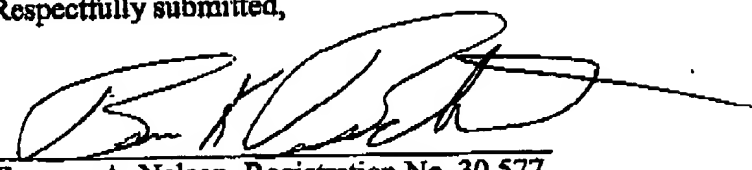
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This limitation is significant to the Applicants' disclosed invention, as the Applicants' specification teaches that the portable computing device is a resource constrained device that conventionally has problems speech recognizing spoken utterances as searches of possible textual matches can require more time using the limited resources of the mobile device that is desired for performance reasons (page 4 of the Applicants' background). The claimed threshold value used in conjunction with limiting a set of selections used to speech recognize utterances ensures that the user of the mobile device is not forced to wait an excessively long period of time for the portable computing device to perform the speech recognition task (page 17, lines 4-9).

Since Lindholm fails to expressly or inherently teach each claimed limitation, the § 102(e) rejections to claims 1-15 should be withdrawn, which action is respectfully requested.

The Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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